

Amendment Dated: August 27, 2010
Response to Official Action Dated: May 28, 2010
Application Serial No. 10/582,192

REMARKS

Reconsideration of this application is respectfully requested. Applicant believes he has complied with every requirement expressly set forth in the Office Action dated May 28, 2010 (Paper No. 20100526A) and believes the application is now in condition for allowance or alternatively, in better form for appeal. A Request for Continued Examination is being submitted along with this Response.

The Examiner has issued a "Claim Warning" regarding Claims 60 because it is considered a substantial duplicate of Claim 14. Amendments have been made to both claims, such that they are sufficiently different. As such, Applicant requests that the warning be withdrawn.

Claims 14-49 and 59-60 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As identified by the Examiner, "in order to be statutory, the claims must pass the machine transformation test and *provide a meaningful tie to (or transformation of) a physical machine (or apparatus)*. In re Bilski" (emphasis added). Applicant has previously submitted arguments on this issue, which the Examiner has denied noting that "a playing court is not a particular machine," and that "there is no transformation of an article in the claims."

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Applicant respectfully disagrees with the Examiner and offers further comments to support the argument that the claims are directed to patentable subject matter. First, Claim 14 recites not only a game area having “at least two physical boundaries,” but it also recites “a pressure pad,” and “at least one hand-to-hand weapon,” which is used to strike the pressure pad. As such, Claim 14 provides a meaningful tie to *three* physical apparatuses, and therefore is more than sufficient to satisfy the Bilski test for patentable subject matter.

Also, Claim 14 recites “defining game play areas,” which results in the ground being transformed into a game play area (e.g., by physically marking the ground). Such language also satisfies that Bilski test by providing a transformation of a physical apparatus.

Finally, notably the Supreme Court recently issued a ruling on Bilski, finding that the Federal Circuit incorrectly concluded that the two-part test described above is the exclusive test for determining patent subject matter eligibility under 35 U.S.C. §101. (561 US ____, 2010). Indeed, the invention discussed in Bilski was deemed to be patentable subject matter because it was not directed merely at an abstract idea. Similarly, the present invention is not directed to an abstract idea. Indeed, the claims recite physical boundaries and components that are used together with a well-defined set of rules to carry out the steps for playing a type of game.

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For each of the reasons individually, Claim 14 satisfies the patentable subject matter requirement of 35 U.S.C. §101. Similar language is recited in the remaining independent claim 60. Therefore, all rejections based on 35 U.S.C. §101 should be withdrawn.

Claims 14-20, 22, 24, 27-29, 31, 33-38, 41, 43-49, and 59-60 stand rejected under 35 U.S.C. §102(e) as being anticipated by Wikipedia, Fencing 6/31/06 (“WF”). WF discloses the game of fencing in which two individuals play each other on a Piste, which the Examiner asserts discloses the claimed “game area.” However, Amended Claim 14 recites, among other things, “a method of playing a team combat sport wherein: each team includes two or more players who combat one another contemporaneously to achieve an objective” (i.e., at least four players total). WF merely discloses “two fencers” plus referees” playing at one time (WF, see header “Participants”), and therefore only discloses two players playing contemporaneously during a match. Notably, while WF makes reference to team events with teams of three fencers, no more than two fencers compete contemporaneously. See Page 12 of WF, which states “modern team competition is similar to the pool round of the individual competition. The fencers from opposing teams will each fence each other once.” Similarly, WF fails to disclose that a single player that may challenge or be challenged

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contemporaneously by one or more opponents in a single game as recited in Claim 14. For these reasons alone, the 35 U.S.C. §102(e) rejection of Claim 14 should be withdrawn.

Further, WF describes the Piste as a strip which is 1.5 to 2 meters long and 14 meters wide, and which, when starting from the mid-point and moving out, there are two en-guard lines (one on each side of the mid-point), followed by two warning lines (one on each side of the mid-point). The lines therefore create three consecutive areas on each side of the mid-point, including the standard play area, the en-guard area, and the warning area. The boundaries of each area contact the boundary of the adjacent area. To the contrary, amended Claim 14 recites, among other things, “at least two physical playing regions having non-contacting boundaries.” Indeed, as shown in FIG. 2, the playing area’s (2, 3) have non-contacting boundaries (i.e., they are separated). This is not the case in WF, which discloses continuous playing areas (i.e., playing areas that share boundaries). Similar arguments are applicable to amended Claim 60, which recites, among other things, a game area comprising “three generally rectangular-shaped lanes, wherein each pair of neighboring lanes is *separated by a non-playing region*” (emphasis added). Notably, support for these claim amendments can be found in Applicant’s Specification on Pages 17-24 and in FIG. 2.

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For all the reasons discussed above, it is respectfully requested that the 35 U.S.C. §102(e) rejection of Claim 14 be withdrawn. Further, since the remaining rejected claims depend from Claim 14, it is also requested that the rejections to the corresponding claims be withdrawn.

Claims 21, 23, 25-26, 30, 32, and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WF as applied to claim 14 above and Wikipedia, Dodgeball 1/20/07 (“WD”), while claim 42 stands rejected under 35 U.S.C. §103(a) as being unpatentable over WF in view of Lohre (U.S. Pat. No. 4,892,303). As discussed above, Claim 14 has been amended to overcome any rejections made by the Examiner based on the WF reference. Therefore, Applicant submits the 35 U.S.C. §103(a) rejections based on either a combination of WF and WD or a combination of WF and Lohre, should be withdrawn.

Further, Applicant submits that it would not be obvious to one of ordinary skill in the art to combine WF and WD. Indeed, WF relates to fencing, which is a game played between two individuals at one time, and one in which each player is simultaneously attacking and defending with combat equipment. On the other hand, WD relates to dodgeball which is a game wherein teams of individuals play each other, but wherein each teams takes “turns” at playing offense and defense. This is quite different from fencing, which has no “turns.” Further, players in dodgeball do not use any equipment other than the ball. Indeed,

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there is no combat equipment including for example, a hand-to-hand weapon, a pressure pad, etc as recited in the claimed invention. As such, aside from merely both being considered “games,” there is little in common between fencing and dodgeball and it is not appropriate to combine them without any particular basis. Notably, the Examiner provides no reason for why these two references should be combined aside from saying “[i]t would have been obvious to one of ordinary skill in the art of the invention to have modified the playing method of [WF with a feature of WD].” As such, it is improper for the Examiner to combine these references to make an obviousness rejection under 35 U.S.C. §103 and therefore the rejection should also be withdrawn for these reasons, as well as those discussed above.

By the above arguments and amendments, Applicant believes that he has complied with all requirements expressly set forth in the pending Office Action. Issuance of a Notice of Allowance on all pending claims is respectfully requested. Should the Examiner

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discover there are remaining issues which may be resolved by a telephone interview, he is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

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